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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/615,883 | 07/09/2003 | Philip Davis | 1019-2 | 9836 |

7590 07/05/2006

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EXAMINER

HOGUE, GARY CHAPMAN

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3611

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 10/615,883 | Applicant(s) DAVIS, PHILIP | |
| | Examiner Gary C. Hoge | Art Unit 3611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 3-8, 14, 17-22 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 9-13, 15, 16 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/9/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 3-8, 14, 17-21, 22 and 28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 10, 2006.

2. Applicant's election with traverse of Species I in the reply filed on April 10, 2006 is acknowledged. However, Applicant did not provide any grounds for the traversal.

In the absence of any argument to the contrary, the requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 15 and 23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Lane (279,490).

Lane discloses a matting system having a carrier mat (c) with at least one window and a display mat (d) having at least one window smaller than the window in the carrier mat, the display mat being adhered to the carrier mat so that the window of the display mat is in-line with the window in the carrier mat; and a frame extension, being established around the window of

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the carrier mat by the smaller window of the display mat relative to the carrier mat (see Fig. 6); a display item positioned in the window of the carrier mat (page 1, lines 87-97); and a backer mat (e) positioned behind the carrier mat.

Regarding claim 23-27, it has been held that apparatus limitations are not entitled to patentable weight in a method claim. *Ex parte Akamatsu*, 22 USPQ2d 1915.

5. Claims 1, 15 and 23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohart (5,279,880).

See Fig. 6. Cohart discloses a matting system having a carrier mat **16** with at least one window **20** and a display mat **10** having at least one window **12** smaller than the window in the carrier mat, the display mat being adhered to the carrier mat (col. 5, lines 11-14) so that the window of the display mat is in-line with the window in the carrier mat; and a frame extension, being established around the window of the carrier mat by the smaller window of the display mat relative to the carrier mat (see Fig. 6); a display item positioned in the window of the carrier mat (page 1, lines 87-97); and a backer mat **24** positioned behind the carrier mat.

Regarding claim 23-27, it has been held that apparatus limitations are not entitled to patentable weight in a method claim. *Ex parte Akamatsu*, 22 USPQ2d 1915.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 2, 9-13, 16 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohart (5,279,880) in view of Lane (279,490).

Cohart discloses the invention substantially as claimed, as set forth above. However, the flap 22 is not hinged to the carrier mat 16. Lane teaches that it was known in the art to hinge such a flap. It would have been obvious to one having ordinary skill in the art at the time the invention was made to hinge the flap disclosed by Cohart, as taught by Lane, in order that the flap might not get lost.

Regarding claims 9 and 23, the hinge disclosed by Lane is gummed tape. The adjective “archival” is a statement of intended use and does not define over the prior art.

Regarding claims 10-13 and 24-27, Lane does not disclose what type of adhesive and what type of tape is contemplated. Because it is within the level of ordinary skill of a worker in the art to select from among known materials on the basis of their suitability for the fabrication of a given device, and since a person having ordinary skill in the art would know that any known tape and any known adhesive, and specifically pressure sensitive linen tape, non-porous film with archival grade adhesive, non-woven polyethylene and acrylic adhesive, and acid-free paper adhered with wheat starch, rice starch or a synthetic methyl-cellulose type paste, would be suitable for the fabrication of a hinge of the type disclosed by Lane, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the hinge disclosed by Lane from pressure sensitive linen tape, non-porous film with archival grade adhesive, non-woven polyethylene and acrylic adhesive, and acid-free paper adhered with wheat starch, rice starch or a synthetic methyl-cellulose type paste as a matter of choice in design, based on such factors as cost and availability of the materials to the designer.

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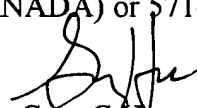
Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Gary C Hoge
Primary Examiner
Art Unit 3611

gch